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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,846	03/12/2001	Tetsushi Nomoto	108611	7817
25944	7590	11/04/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			SINGH, SATWANT K	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/802,846	<b>Applicant(s)</b> NOMOTO, TETSUSHI	
	<b>Examiner</b> Satwant K. Singh	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, and 12-47 is/are rejected.
- 7) ☐ Claim(s) 9 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, and 12-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkle et al. (US 6,017,157).
3. Regarding Claim 1, Garfinkle et al disclose a method for providing a print of a digital image registered by a registrant in response to an order from a viewer comprising: a first step of receiving the digital image from the registrant (digital images are acquired) (col. 3, lines 51-54); a second step of registering the received digital image (unique access code is associated with the digital images) (col. 4, lines 6-20, 57-67); a third step of showing the registered digital image to the viewer (digital image are accessed at the image server) (col. 5, lines 1-10); a fourth step of accepting the order for the print of the digital image from the viewer (order a visual print of a specific image) (col. 5, lines 19-28); a fifth step of producing the ordered print of the digital image (once an order is placed, the order is fulfilled and delivered) (col. 8, lines 14-25); a sixth step of billing the print charge to the registrant (when an order is placed for a visual print, the photographer provides the appropriate billing and shipping information and this information is stored on the image server) (col. 9, lines 14-32).

4. Regarding Claim 2, Garfinkle et al disclose a method wherein the first step includes a step of receiving a digital image with a discrimination denoting that the print charge of the digital image is to be paid by the registrant (when a new access code is assigned, a price sheet must be associated with these images in order to provide to the photographer 8 the visual prints which may be ordered using the new images) (col. 9, lines 1-13); wherein the second step includes a step of recording the digital image with the discrimination together with the discrimination (price sheet associated with these images) (col. 9, lines 1-13); and wherein the sixth step includes a step of billing the print charge of the print of the digital image with the discrimination to the registrant (when a order is placed for a visual print, the photographer provides the appropriate billing and shipping information and this information is stored on the image server) (col. 9, lines 14-32).

5. Regarding Claim 3, Garfinkle et al teach a method wherein the third step includes a step of permitting only a viewer with a predetermined identification to view the image with the discrimination (unique access code is associated with the digital images to facilitate secure viewing of the images) (col. 4. lines 57-67).

6. Regarding Claim 4, Garfinkle et al teach a method wherein the fourth step includes a step of allowing only a viewer with a predetermined identification (selective authorized access to an image of the developed image is then provided through the use of the interface B) (col. 4. lines 55-56) to order the print of the digital image with the discrimination (interface B allows the photographer 8 to perform specific tasks using the

digital images, such as .....or order a visual print of a specific image) (col. 5, lines 19-28).

7. Regarding Claim 5, Garfinkle et al teach a method wherein the first step is carried out through a computer communication with the registrant (digital image form the digital camera of the photographic image is uploaded directly to one or more of the image servers) (col. 2, lines 61-64).

8. Regarding Claim 6, Garfinkle et al teach a method wherein the third (digital images are access at the image server through the use of the interface B by HTML pages on the WWW or a client interface accessing an image server using a proprietary protocol over a computer network such as the Internet) (col. 5, lines 1-10) and fourth interface B allows the photographer 8 to perform specific tasks using the digital images, such as .....or order a visual print of a specific image) (col. 5, lines 19-28) steps are carried out through a computer communication with the registrant.

9. Regarding Claim 12, Garfinkle et al disclose a method further comprising a step of making it possible to accept a print order whose print charge is paid by the viewer and a step of billing the print charge to the viewer (when an order is placed for a visual print, the photographer provides the appropriate billing and shipping information) (co. 9, lines 25-32).

10. Regarding Claim 13, Garfinkle et al disclose a method further comprising a step of adding the number of prints of a digital image on the viewer's account to that of the same digital image on the register's account, wherein the fifth step produces the sum for the number of the prints on such a digital image (images are either added to a set of

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images already associated with the access code or the new images are assigned a new unique access code) (col. 9, lines 1-13).

11. Regarding Claim 14, Garfinkle et al disclose a method further comprising a step of setting a time limit to the fourth step, whereby the fourth step accepts the order leading to the sixth step only when the order is made within the time limit (the digital images for a roll of film are maintained at the image server for a fixed period of time) (col. 5, lines 39-43).

12. Regarding Claim 15, Garfinkle et al disclose a method wherein a plurality of orders are acceptable for a period (digital images for a roll of film are maintained at the image server for a fixed period of time) (col. 5, lines 36-44), wherein the fifth step produces the prints by summing up the orders within the period with respect to each digital image (fulfillment of orders)(once an order has been places, the order is fulfilled and delivered) (col. 9, lines 14-25).

13. Regarding Claim 16, Garfinkle et al disclose a method further comprising a step of accepting an order for purchasing a product of digital contents relating to the digital image (order a visual print of a specific image) and a step of selling the product by copying the digital contents on a recording medium of the viewer (e-mail or downloading images) (col. 5, lines 19-29).

14. Claims 17, 18, 21, and 44 are rejected for the same reason as claim 1.

15. Regarding Claim 19 Garfinkle et al disclose a method further comprising a step of setting a time limit to the fourth step, whereby the fourth step accepts the order leading to the sixth step only when the order is made within the time limit (digital images

for a roll of film are maintained at the image server 16 for a fixed period of time) (col. 5, lines 36-44).

16. Claim 20 is rejected for the same reason as claim 3.

17. Regarding Claim 22, Garfinkle et al disclose an apparatus for providing a print of a digital image comprising: an image input that receives a digital image from an image registrant (scanning center 14) (col. 3, lines 12-19); a memory that records the received digital image (image server 16) (col. 3, lines 62-63); an image output that outputs the digital image in order to make a viewer view the recorded digital image (interface B) (col. 63-67); a print order acceptor that accepts an order for a print of the viewed digital image (fulfillment center 20) (col. 3, lines 14-18); an image data output that outputs an image data of the ordered digital image to a printer (fulfillment center 20) (col. 3, lines 14-18); and a billing data output that outputs a data for billing the print charge to the registrant (fulfillment center 20) (col. 3, lines 14-18).

18. Regarding Claim 23, Garfinkle et al disclose a method of providing a print of an image registered by a registrant in relation to a product of digital contents to be sold by the registrant and purchased by a purchaser comprising: a first step of receiving information of the image from the registrant through a computer communication (digital images are acquired) (col. 3, lines 51-54); a second step of producing the print of the image based on the information (once an order is placed, the order is fulfilled and delivered) (col. 8, lines 14-25); and a third step of billing a print charge to the registrant (when an order is placed for a visual print, the photographer provides the appropriate

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billing and shipping information and this information is stored on the image server) (col. 9, lines 14-32).

19. Regarding Claim 24, Garfinkle et al disclose a method wherein the information of the image is a kind of information including an image data of a digital image (access code, a name, phone number e-mail address, etc.....and other desired information may be assigned and/or collected for each roll of film) (col.4, lines 57-67).

20. Regarding Claim 25, Garfinkle et al disclose a method wherein the information of the image includes information that specifies the image (access code, a name, phone number e-mail address, etc.....and other desired information may be assigned and/or collected for each roll of film) (col.4, lines 57-67).

21. Regarding Claim 26, Garfinkle et al disclose a method wherein the specified image is an image recorded on a film (photographic film) (col. 2, lines 53-64).

22. Regarding Claim 27, Garfinkle et al disclose a method wherein the specified image is a digital image (digital image) (col. 2, lines 61-64).

23. Regarding Claim 28, Garfinkle et al disclose a method further comprising a step of obtaining the image data of the specified digital image from outside (digital image from the digital camera of the photographic image is uploaded directly to one of more of the image servers 16) (col. 2, lines 61-64).

24. Regarding Claim 29, Garfinkle et al disclose a method further comprising a step of receiving information regarding the kind of the recording medium on which the digital contents purchased by the contents purchaser are recorded (interface B allows the photographer to perform specific tasks using the digital images) (col. 5, lines 20-29).



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25. Regarding Claim 30, Garfinkle et al disclose a method further comprising a step of selecting a paper for the print and contents of the print other than the image based on the information regarding the kind of the recording medium, and a step of printing the contents of the print other than the image in a predetermined area of the paper (order a visual print of a specific image in a variety of formats and sizes) (col. 5, lines 20-29).

26. Regarding Claim 31, Garfinkle et al disclose a method further comprising a step of receiving information to deliver the print to the purchaser (photographer provide the appropriate billing and shipping information) (col. 9, lines 25-32).

27. Claim 32 and 36 are rejected for the same reasons as claim 23.

28. Claim 33 is rejected for the same reason as claim 24.

29. Claim 34 is rejected for the same reason as claim 4.

30. Claims 35 and 45 are rejected for the same reason as claim 5.

31. Regarding Claim 37, Garfinkle et al disclose a method of providing a print of an image registered by a registrant in relation to a product of digital contents to be sold by the registrant and purchased by a purchaser comprising: a first step of selling the product of digital contents to a purchaser (order a visual print of a specific image in a variety of formats and sizes) (col. 5, lines 20-29); and a second step of outputting information relating to the image through a computer communication for the purpose of producing the print (image server 16 is connected to the Internet to allow the processed digital images to be accessed from remote locations) (col. 5, lines 35-39).

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32. Regarding Claim 38, Garfinkle et al disclose a method wherein the first step includes a step of copying the digital contents on a recording medium of the purchaser (e-mail or download an image) (col. 5, lines 20-29).

33. Regarding Claim 39, Garfinkle et al disclose a method further comprising a step of making the purchaser select one of a plurality of images relating to the digital contents (thumbnails of the digital images) (col. 5, lines 15-20).

34. Claim 40 is rejected for the same reason as claim 24.

35. Claim 41 is rejected for the same reason as claim 25.

36. Regarding Claim 42, Garfinkle et al disclose a method further comprising a step of getting information necessary for delivering the print to the purchaser (when an order is placed for a visual print, the photographer provides the appropriate billing and shipping information and this information is stored on the image server) (col. 9, lines 25-33); and a step of outputting information for the delivery through a computer communication (image server is connected to the internet) (col. 5, lines 35-36).

37. Claim 43 is rejected for the same reason as claim 22

38. Regarding Claim 46, Garfinkle et al disclose a method further comprising a step of having the registrant issue an identification of the image to the purchaser (the photographer refers to any party having authorized access to the images) (col. 3, lines 9-12), and a step of having the printer receive the identification from the purchaser (selective authorized access to an image of the developed image is then provided through the use of the interface B) (col. 4. lines 55-56).

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39. Regarding Claim 47, Garfinkle et al disclose a method further comprising a step of having the registrant issue a password to the purchaser (the photographer refers to any party having authorized access to the images) (col. 3, lines 9-12), and wherein the third step is only effective when the password is input to the (selective authorized access to an image of the developed image is then provided through the use of the interface B) (col. 4. lines 55-56).

***Claim Rejections - 35 USC § 103***

40. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

41. Claims 7, 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. (US 6,017,157) in view of Ueda (US 6,714,314).

42. Regarding Claim 7, Garfinkle et al fail to teach a method further comprising a step of setting a limit to the order from the viewer, wherein the fourth step includes a step for accepting the order leading to the sixth step when the order is within the limit.

Ueda teaches a method further comprising a step of setting a limit to the order from the viewer, wherein the fourth step includes a step for accepting the order leading to the sixth step when the order is within the limit (print service dealing information input means 22) (col. 6, lines 9-22).

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Garfinkle with the teaching of Ueda to only complete printing orders meeting the limitations set by the viewer.

43. Regarding Claim 10, Garfinkle et al fail to teach a method wherein the limit is the number of ordered prints

Ueda teaches a method wherein the limit is the number of ordered prints (instructing the producing of photographic prints to the number of prints inputted by said input means) (col. 10, lines 22-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Garfinkle with the teaching of Ueda to only complete printing orders meeting the limitations set by the viewer.

44. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle and Ueda as applied to claim 7 above, and further in view of Maruta et al (US 6,516,157).

45. Regarding Claim 8, Garfinkle et al and Ueda fail to teach a method wherein the limit is a sum of print charge.

Maruta et al teach a method wherein the limit is a sum of print charge (user can identify printing cost OF in advance before print out is executed by copy machine 3, print condition PC can be altered when the expense for print out is too high) (col. 17, lines 11-15, 22-27, 39-55).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Garfinkle and Ueda with the teaching of Maruta to only complete printing orders meeting the limitations set by the viewer.

***Allowable Subject Matter***

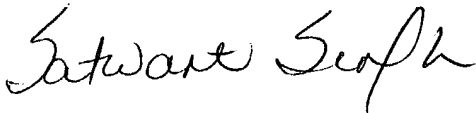
46. Claims 9, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

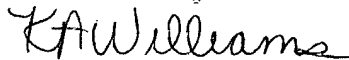
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Satwant K. Singh  
Examiner  
Art Unit 2626

sks



**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**